

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Jonathan Stinson
Application No.:	10/037036
Filed:	October 25, 2001
For:	Balloon Expandable Polymer Stent With Reduced Elastic Recoil
Patent No.:	7572287
Issue Date:	August 11, 2009
Examiner:	Vi X Nguyen
Group Art Unit:	3734

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: S63.2B-9919-US01

**Request for Reconsideration of Application for Patent Term
Adjustment for Office Failure to Issue the Patent Within 3 Years**

On December 22, 2008 the applicant filed a request for reconsideration of patent term adjustment for the above patent application arguing that the Office improperly has not included three year delay term days and citing *Wyeth v. Dudas*, 88 USPQ2d 1538 (DC DC 2008).

On July 15, 2009 the Senior Petitions Attorney issued a paper holding decision on that request in abeyance until the patent had issued on the ground that the Office does not calculate the time under 37 CFR 1.702(b) until the issue date has been determined and giving the applicant two months after the issue date, without additional fee, to request reconsideration in light of the final patent term adjustment calculated by the Office. A copy of the July 15, 2009 decision is attached.

The applicant hereby requests reconsideration of the patent term adjustment determination made by the Director and reported in the Issue Notification attached.

The patent issued on the August 11, 2009 with a final Patent Term Adjustment calculated at 1718 days. A copy of the USPTO PAIR record showing the calculation of the 1718 days is also attached. Although no days are listed as "three years" days, under the PAIR heading "Patent Term Adjustment" the USPTO delay days is given as 1751 days which corresponds to the time from the three year anniversary to the issue date, not the 868 PTO days shown on the "Patent Term Adjustment History" heading (some of the latter of which overlaps the three year delay). It thus appears that the PAIR record calculated USPTO delay using only the 3 years delay without including the USPTO delay days that do not overlap with the 3 year delay. This violates the decision of *Wyeth v. Dudas*, which holds that the days of USPTO delay in the prosecution history that are non-overlapping are to be added to the three years days.

The applicant submits that under *Wyeth v. Dudas*, the proper calculation is as follows:

Three Year delay days	1751
Non-overlapping USPTO Delay days (i.e. those shown in PAIR record prior to 10/26/2004)	404
Applicant delay days (as shown in PAIR record)	<u>(33)</u>
Correct Patent Term Adjustment days	2122

All items required under 37 CFR 1.705 having been provided, the applicant requests that the Determination of Patent Term Adjustment provided in the Issue Notification be corrected to show an adjustment of **2122** days.

Finally it is noted that the decision *Wyeth v. Dudas*, has been appealed by the Office to the Federal Circuit and that appeal is currently pending. The question of law decided therein will be dispositive on the issue presented in this request and it is assumed that the Office will conform its calculations of patent term adjustments to the decision on the appeal. Therefore it is suggested that this request should be held in abeyance until the decision in the Office's appeal of *Wyeth* has been issued.

Conclusion

For the reasons given above the applicant requests that the Patent Term Adjustment of 1718 days provided in the Issue Notification be corrected to **2122** days.

Respectfully submitted,
VIDAS, ARRETT & STEINKRAUS

Date: September 9, 2009

By: /Walter J. Steinkraus/
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f:\wpwork\wjs\09919us01 patent term extension 20090803.doc

Attachments:

July 15, 2008 decision "On Application For Patent Term Adjustment" (2 pages)
Issue notification (1 pg)
Pair Record showing USPTO patent term calculation (2 pages)



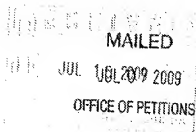
UNITED STATES PATENT AND TRADEMARK OFFICE

891-374536

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Paper No.

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6640 SHADY OAK ROAD
EDEN PRAIRIE MN 55344



In re Application of :
Jonathan S. Stinson :
Application No. 10/037,036 : ON APPLICATION FOR
Filed: October 25, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. S63.2-9919- :
USQ1 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT, 37 CFR 1.705 filed on December 22, 2008. Applicant requests that the determination of patent term adjustment be increased by one thousand one hundred seventy (1170) days to one thousand nine hundred ten (1910) days.¹ Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the

¹ Applicant calculates the three year period as 1170 days, counting the number of days over three years until the mailing of the notice of allowance on October 3, 2008. Applicant requests additional days for the interval from the mailing of the notice of allowance to the issue date.

patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	ISSUE DATE	PWENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10037.036	08/11/2009	7572287	863.2-9919 US91	5380

400 7590 01/22/2009
VIDAS, ARRETT & STEINKRAUS, P.A.
SUITE 400, 6640 STEADY OAK ROAD
EDEN PRAIRIE, MN 55344

JUL 28 2009

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 1718 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Jonathan S. Stinson, Plymouth, MN;



United States Patent and Trademark Office

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10/037,036

BALLOON EXPANDABLE POLYMER STENT WITH REDUCED ELASTIC RECOIL

PT

☐ Patent Documentation

Select	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Published Documents	Address & Attorney Agent
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☐ Fees☐ Supplemental Resources & Support

Patent Term Adjustment

Patent Information

☐ Patent Information and General Info☐ Codes, Rules & Manuals☐ Knowledge & Office Practices☐ Resources & Public Notices

Filing or 371(c) Date:	10-25-2001	USPTO Delay (PIO) Delay (days):	1751
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	33
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	1718
USPTO Adjustment (days):	-0	Explanation Of Calculations:	<input checked="" type="checkbox"/>

Patent Term Adjustment History

Patent Official Gazette

☒ Search Patents & Applications☐ Search Biological Sequences☐ Codes, Products & Services

Date	Contents Description	PTO(Days)	APPL(Days)
07-22-2009	PTA 36 Months		865
07-13-2009	Dispatch to POC	+	
07-07-2009	Mail-Petition Decision - Dismissed	+	
07-07-2009	Petition Decision - Dismissed	+	
12-22-2008	Petition Entered	+	
12-31-2008	Application Is Considered Ready for Issue	+	
12-23-2008	Issue Fee Payment Verified	+	
12-23-2008	Issue Fee Payment Received		
10-03-2008	Mail Notice of Allowance		
10-01-2008	Document Verification		
10-01-2008	Notice of Allowance Data Verification Completed		
09-22-2008	Date Forwarded to Examiner		
09-16-2008	Appeal Brief Filed		
09-16-2008	Notice of Appeal Filed		
06-30-2008	Mail Non-Final Rejection	109	
06-23-2008	Non-Final Rejection	+	
12-08-2007	Appeal Brief Review Complete	+	
12-08-2007	Date Forwarded to Examiner	+	
11-13-2007	Appeal Brief Filed	+	
09-12-2007	Notice of Appeal Filed		
07-13-2007	Mail Final Rejection (PTOL - 325)		
07-05-2007	Final Rejection		
05-03-2007	Date Forwarded to Examiner		
04-23-2007	Response after Non-Final Action		
02-05-2007	Mail Non-Final Rejection		
02-04-2007	Non-Final Rejection		
11-25-2006	Date Forwarded to Examiner		
11-15-2006	Amendment after Final Rejection		
10-11-2006	Mail Final Rejection (PTOL - 325)		
10-02-2006	Final Rejection		
08-03-2006	Date Forwarded to Examiner		
08-01-2006	Response after Non-Final Action		
07-05-2006	Mail Non-Final Rejection		

Other

☐ Copyrights☐ Trademarks☐ Policy & Fees☐ Reports

06-27-2006	Non-Final Rejection	
04-17-2006	Case Docketed to Examiner in GAU	
03-21-2006	Date Forwarded to Examiner	
03-17-2006	Response to Election / Restriction Filed	
03-03-2006	Mail Restriction Requirement	250
03-01-2006	Requirement for Restriction / Election	+
12-27-2005	Date Forwarded to Examiner	+
02-16-2005	Appeal Brief Filed	+
11-29-2005	Miscellaneous Incoming Letter	
12-08-2004	Letter Requesting Interview with Examiner	
12-20-2004	Notice of Appeal Filed	
11-11-2004	Miscellaneous Incoming Letter	
10-05-2004	Mail Final Rejection (PTOL - 326)	4
10-04-2004	Final Rejection	+
07-21-2004	IFW TSS Processing by Tech Center Complete	+
05-15-2003	Reference capture on IDS	+
06-24-2002	Reference capture on IDS	+
02-27-2002	Reference capture on IDS	+
07-21-2004	Date Forwarded to Examiner	+
06-01-2004	Response after Non-Final Action	33
06-01-2004	Request for Extension of Time - Granted	+
06-01-2004	Workflow Incoming petition IFW	+
06-01-2004	Workflow incoming amendment IFW	+
01-29-2004	Mail Non-Final Rejection	400
01-28-2004	Non-Final Rejection	+
12-04-2003	Case Docketed to Examiner in GAU	+
05-15-2003	Information Disclosure Statement (IDS) Filed	+
05-15-2003	Information Disclosure Statement (IDS) Filed	+
12-16-2002	Case Docketed to Examiner in GAU	+
06-24-2002	Information Disclosure Statement (IDS) Filed	+
06-24-2002	Information Disclosure Statement (IDS) Filed	+
02-27-2002	Information Disclosure Statement (IDS) Filed	+
02-27-2002	Information Disclosure Statement (IDS) Filed	+
03-16-2002	Case Docketed to Examiner in GAU	+
02-01-2002	Application Dispatched from OIPE	+
01-31-2002	Application Is Now Complete	+
01-16-2002	IFW Scan & PACR Auto Security Review	+
10-25-2001	Initial Exam Team run	+

If you need help:

- Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail PEC@uspto.gov for specific questions about Patent Application Information Retrieval (PAIR).
- Send general questions about USPTO programs to the [USPTO Contact Center \(USPTO.CC\)](mailto:USPTO.Contact.Center@USPTO.gov).
- If you experience technical difficulties or problems with this application, please report them via e-mail to [Electronic Business Support](mailto:Electronic.Business.Support@uspto.gov) or call 1 800-766-9199.

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